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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,268	02/16/2001	Jonathan W. Jarvik		5282

7590 11/20/2008
JONATHAN W. JAVIK, PHD.
6419 BEACON STREET
PITTSBURGH, PA 15217

EXAMINER

NEGIN, RUSSELL SCOTT

ART UNIT	PAPER NUMBER
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1631

MAIL DATE	DELIVERY MODE
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11/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/788,268

Applicant(s)

JARVIK, JONATHAN W.

Examiner

RUSSELL S. NEGIN

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 102-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 102-112 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Comments

Applicant's arguments, see Remarks, filed 25 August 2008, with respect to 35 U.S.C. 103 have been fully considered and are persuasive. The 35 U.S.C. 103 rejections of the Office action of 27 May 2008 have been withdrawn. This application is in condition for allowance except for the following formal matters.

Specification

The following objections are reiterated from the previous Office action:

The disclosure is objected to because of the following informalities:

There are drawings embedded in the specification on pages 31 and 33 (see the most recent version of the specification filed on 1 July 2005).

These drawings are partially cut off on the right side of the figure.

Page 8 of the specification has the grammatical inconsistency on line 4, "the codons encoding each amino acid [amino acid] in the sequence."

Page 14, line 8 has the units inconsistency, "A 10 ϕ l aliquot..."

Page 17, line 7 has the units inconsistency, "A 10 ϕ l aliquot..."

Page 41, line 16 has an ending to a sentence with two periods.

Appropriate correction is required.

It should be noted that the Remarks of the Applicant are technically not fully responsive because they fail to address these objections. Consequently, in the

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absence of arguments or amendments to overcome these objections, they are maintained. However, in the interest of advancing prosecution, the application is examined as it stands.

Allowable Subject Matter

Claims 102-112 are allowed.

The prior art does not teach or suggest a method for analyzing a polynucleotide by comparing the calculated masses with the measured (i.e. expressed) masses wherein masses of the two or more polypeptides are obtained from DIFFERENT reading frames. The claims are fully enabled, have utility, and are statutory (i.e. there is a physical step of expression).

Conclusion

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the central PTO Fax Center. The faxing of such pages must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61

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(November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)).

The Central PTO Fax Center Number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Negin, Ph.D., whose telephone number is (571) 272-1083. The examiner can normally be reached on Monday-Friday from 7am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Marjorie Moran, Supervisory Patent Examiner, can be reached at (571) 272-0720.

Information regarding the status of the application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information on the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/RSN/
Russell S. Negin
13 November 2008

/Marjorie Moran/
Supervisory Patent Examiner, Art Unit 1631